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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/237,219 | 01/25/1999 | DOUGLAS T. ROSENOFF | 962.002US1 | 9491 |

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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER

NGUYEN, MAIKHANH

ART UNIT PAPER NUMBER

2176

DATE MAILED: 09/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/237,219

Applicant(s)

ROSENOFF ET AL.

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 14, 15, 17 and 19-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 14, 15, 17 and 19-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: amendment B filed 09/03/2002 to the application filed 01/25/1999.
2. Claims 1-9, 14-15, 17 and 19-49 are currently pending in this application. Claims 1-5, 6, 14, and 17 have been added by Applicant. Claims 1- 6, 14 and 17 are independent claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-9, 14-15, 17 and 19-49 are rejected under 35 U.S.C. 102(e) as being anticipated by **Sotomayor** (U.S 5,708,825- filed May 26, 1995).

As to independent claim 6, Sotomayor teaches an automated method of defining hyperlinks for a document (incorporate hyperlinks within a single document and between documents; col.8, lines 18-25), comprising:

- automatically marking one or more portions of the document (automatically identifying significant key topics, concepts, and phrases in the documents; abstract / automatically identifies key topics and phrases in a document's text; col.3, line 63- col.4, line 8); and

- defining one or more hyperlinks for one or more of the marked portions of the document, with each hyperlink including at least a portion of one of the marked portions of the document (creating summary pages for, and hyperlinks between, some or all of these key topics; abstract/ inserts identifying tokens for hyperlinks to those key topics; col.3, line 63- col.4, line 8).

As to dependent claim 7, Sotomayor teaches each hyperlink further includes account information for a user (www.myserver.com/user1; col.11, lines 9-18).

As to dependent claim 8, Sotomayor teaches each hyperlink includes a domain name common to all the hyperlinks (www.myserver.com; col.11, lines 9-18).

As to dependent claim 9, Sotomayor teaches each hyperlink includes a domain name common to all the hyperlinks and information based on a syntactic or semantic analysis of at least a portion of one of the marked portions of the document (key-topic entries are key concepts and associated hyperlinks that were automatically generated from source documents... identify particularly high semantic weight key words; col.14, lines 52-59).

Independent claim 2, the rejection of independent claim 6 above, is incorporated herein in full.

Claim 2, however, further recites:

- automatically inserting hyperlinks into a document; and
- a step for searching one or more documents for content having one or more predefined forms.

Sotomayor teaches:

- automatically inserting hyperlinks into a document (hyperlinks into the documents...to hyperlink through automatically generated hyperlinks; col.4, lines 24-45); and

- a step for searching one or more documents for content having one or more predefined forms (automatically identifies significant key topics within the selected documents; col.4, lines 24-35).

As to independent claim 1, includes the same subject matter as in claim 2, and is similarly rejected under the same rationale.

Independent claim 3 is directed to a computer system for performing the method of the claim 2, and is similarly rejected under the same rationale.

Independent claim 4 is directed to a computer system for performing the method of the claim 2, and is similarly rejected under the same rationale.

However, claim 4 further recites “a processor” and “a memory.”

Sotomayor teaches a processor (a web browser; col.5, line 53) and a memory (memory; col.5, line 64).

Independent claim 5 is directed to a computer-readable medium for implementing the method of claim 2, and is similarly rejected under the same rationale.

As to independent claim 14, includes the same subject matter as in claim 2, and is similarly rejected under the same rationale.

As to dependent claim 15, Sotomayor teaches providing one or more user preferences includes retrieving information related to one or more preferred hyperlink destinations, or information related to cost, or information related to access time; and wherein defining the hyperlink includes selecting the one destination based on the retrieved preferences (conveys information regarding a key topic to a



viewer...a destination anchor 76 is an anchor placed in a file at a hyperlink destination 74; col.6, lines 32-47).

As to dependent claim 29, Sotomayor teaches providing one or more user preferences includes retrieving information related to cost; and defining the hyperlinks including selecting the one destination based on cost (The author may also make a selection of hyperlinks; col.12, lines 10-38).

As to dependent claim 30, Sotomayor teaches providing one or more user preferences includes retrieving information related to access time; and defining the hyperlinks including selecting the one destination based on access time (The author may also make a selection of hyperlinks; col.12, lines 10-38).

As to dependent claim 31, Sotomayor teaches one of two or more destination is within the computer system and another of the two or more destinations is without the computer system (hyperlink destinations; col.9, lines 11-45).

As to independent claim 17, includes the same subject matter as in claim 2, and is similarly rejected under the same rationale.

As to dependent claim 19, Sotomayor teaches the one or more predefined forms includes citations to printed publication (At run time...The citation token, if chosen, will be replaced by the filename of the output document 64; col.28, lines 14-17).

As to dependent claim 20, Sotomayor teaches one or more of the marked portions includes a citation to a document, the citation including a volume identifier, a page identifier, and publication identifier, and wherein at least one of the generated hyperlinks includes volume, page, and publication

identifiers (automatically identifying significant key topics, concepts, and phrases in the documents; abstract).

As to dependent claim 21, Sotomayor teaches one or more of the generated hyperlinks includes at least one query connector (the viewer with an indexed and/or hyperlinked view of a semantically-analyzed form of that document...search for text strings as in a conventional text-viewing program, as well as having semantically important key topics marked and indexed, and having hyperlinks between the index and key topics and/or between key topics as marked in the text of the document; col.35, lines 48-57).

As to dependent claim 22, Sotomayor teaches one or more of the generated hyperlinks further includes at least one search instruction (search for text strings...between key topics as marked in the text of the document; col.35, lines 48-57).

As to dependent claim 23, Sotomayor teaches one or more of the generated hyperlinks further includes a search-method identifier (automatically identifies significant key topics within the selected documents; abstract).

As to dependent claim 24, Sotomayor teaches the search-method identifier identifies one of a natural-language search method and a Boolean search method (search for text strings...between key topics as marked in the text of the document; col.35, lines 48-57).

Dependent claim 25 includes the same subject matter as in claim 2, and is similarly rejected under the same rationale.

As to dependent claim 26, Sotomayor teaches one or more of the generated hyperlinks further includes information identifying a third-party sponsor for facilitating access to a document in a database associated with the one hyperlink (identified by HTML heading tokens; col.14, lines 31-51).

As to dependent claim 27, Sotomayor teaches associating at least one of the generated hyperlinks with at least one of the marked portions (inserts identifying tokens for hyperlinks to those key topics; col.3, line 63- col.4, line 8/hyperlinks into the documents...to hyperlink through automatically generated hyperlinks; col.4, lines 24-45).

As to dependent claim 28, Sotomayor teaches associating at least one of the generated hyperlinks with at least one of the marked portions includes associating at least one of the generated hyperlinks with at least two of the marked portions (inserts identifying tokens for hyperlinks to those key topics; col.3, line 63- col.4, line 8/hyperlinks into the documents...to hyperlink through automatically generated hyperlinks; col.4, lines 24-45).

As to dependent claim 41, Sotomayor teaches associating at least one of the generated hyperlinks with at least one of the marked portions includes anchoring at least one of the generated hyperlinks to at least one of the marked portions (inserts identifying tokens for hyperlinks to those key topics; col.3, line 63- col.4, line 8/hyperlinks into the documents...to hyperlink through automatically generated hyperlinks; col.4, lines 24-45)

Dependent claim 32-34 and 35 include the limitations as in claims 20-22 and 47, and are similarly rejected under the same rationale.

Dependent claims 36-37 and 38 include the limitations as in claims 25-26 and 28, and are similarly rejected under the same rationale.

As to dependent claim 39, Sotomayor teaches associating at least one of the generated hyperlinks with at least one of the marked portions (inserts identifying tokens for hyperlinks to those key topics; col.3, line 63- col.4, line 8/hyperlinks into the documents...to hyperlink through automatically generated hyperlinks; col.4, lines 24-45)

As to dependent claim 40, Sotomayor teaches associating at least one of the generated hyperlinks with at least one of the marked portions includes associating at least of the generated hyperlinks with at least two of the marked portions (inserts identifying tokens for hyperlinks to those key topics; col.3, line 63- col.4, line 8/hyperlinks into the documents...to hyperlink through automatically generated hyperlinks; col.4, lines 24-45)

As to dependent claim 42, Sotomayor teaches searching the one or more documents comprises searching for citations to other publication (At run time...The citation token, if chosen, will be replaced by the filename of the output document 64; col.28, lines 14-17).

As to dependent claim 43 includes the same limitations as in claim 42, and is similarly rejected under the same rationale.

As to dependent claim 44, “ searching the one or more documents comprises searching for proper names” is inherent to the system of Sotomayor.

Dependent claims 45 and 46 include the limitations as in claims 32 and 21, and are similarly rejected under the same rationale.

Dependent claim 47 includes the same limitations as in claim 35, and is similarly rejected under the same rationale.

Dependent claims 48-49 include the same limitations as in claims 25-26, and are similarly rejected under the same rationale.

Response to Arguments

4. Applicants’ arguments with respect to claims 1-9, 14-15, 17 and 19-49 have been considered but are moot in view of the new ground(s) rejection.

Applicants arguments presented issued which required the Examiner to further view the previous rejection. The Examiner conducted a further search regarding the issues mentioned in Applicant's response. Therefore, all arguments regarding the cited references of the previous rejection are moot in view of the new grounds of rejection.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (703) 306-0092. The examiner can normally be reached on Monday - Friday from 8:30am – 6:00 pm. The Examiner can also be reached on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (703) 308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5403 for regular communications and (703) 308-5403 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Contact Information:

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or fax to:

AFTER-FINAL faxes must be signed and sent to (703) 746-7238.

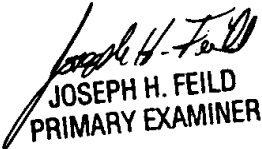
OFFICIAL faxes must be signed and sent to (703) 746-7239.

NON OFFICIAL faxes should be sent to (703) 746-7240.

All OFFICIAL faxes will be handled and entered by the docketing personnel. The date of entry will correspond to the actual FAX reception date unless that date is a Saturday, Sunday, or a Federal Holiday within the District of Columbia, in which case the official date of receipt will be the next business day. The application file will be promptly forwarded to the Examiner unless the application file must be sent to another area of the Office, e.g., Finance Division for fee charging, etc.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist). All hand-delivered responses will be handled and entered by the docketing personnel. Please do not hand deliver responses directly to the Examiner.

Maikhanh Nguyen
September 15, 2002


JOSEPH H. FEILD
PRIMARY EXAMINER